

	NEW 2021	NEW 2021	NEW 2021	Part of the Lanham Act from its original enactment
Type of Proceeding	Section 16A Ex Parte Petition for Expungement	Section 16B Ex Parte Petition for Reexamination	Section 14(6) Inter Partes Cancellation Due to Non-Use	Inter Partes Abandonment
Basis	Mark has never been used in commerce with some or all goods or services covered by the registration.	Mark was not used in commerce for some or all goods/services on the "relevant date" prior to issuance of registration.	Mark has never been used in commerce with some or all of the goods or services covered by the registration.	Abandonment
Statutory authority	TMA Sec. 225(a) added Sec. 16A to Lanham Act.	TMA Sec. 225(c) added Sec. 16B to Lanham Act.	TMA Sec. 225(b) added new Sec. 14(6) to Lanham Act.	Lanham Act Section 14(3)
When proceeding may be commenced.	Between 3 and 10 years after issuance of registration, except can be filed even after more than 10 years from issuance of registration, for petitions filed before Dec 27, 2023	During the first five years following the date of the registration	Any time after the three-year anniversary of the registration .	At any time.
Standing required?	No, can be filed by anyone. Real party in interest can remain anonymous, although the Director is authorized to require that the real party in interest be identified (this power expected to be exercised only in cases of possible abuse or bad actors). The Director can institute proceedings on his/her own initiative.		Yes .	
Relevant Date when mark must have been in use	Registrant's evidence of use must show use before the filing date of the petition to expunge (if filed by a third party under 2.91(a)) or before the date the proceeding was instituted (if instituted on Director's initiative under 2.91(b)).	Fundamentally, on or before the date on which use was claimed. This varies depending on whether the application was originally filed with a 1(a) or 1(b) basis . For applications filed based on 1(a) initially and never amended to 1(b), the application filing date. For applications filed based on (or later amended to) 1(b), the latest of the date when the Amendment to Allege Use was filed, or the expiration of the deadline to file a Statement of Use, including all approved extension periods.	Before filing date of the petition for cancellation.	
Pleadings	Petitioner must submit a petition with a verified statement that sets forth the elements of the reasonable investigation the petitioner conducted to determine that the mark has never been used in commerce on or in connection with the goods and services identified in the petition, with an index of accompanying evidence. See Sec. 2.91(d) .		Notice pleading. TBMP 309.03(c)(1)	
Notice	The USPTO plans to send a courtesy email notification of the filing of the petition to the registrant and/or the registrant's attorney, as appropriate, if an email address is of record. Further notice of determinations in the case will be provided to the registrant and petition, including information to access the petition. The petition will be posted in the TSDR system.		TTAB institutes the proceeding and sends notice to registrant TBMP Sec. 309.02(c)(2) .	

Procedure	If the Director determines that the petition sets forth a prima facie case (requires only that a reasonable predicate concerning nonuse be established) Director will institute a proceeding which follows the procedures for examination under Section 12(b), but is substantively limited to the question of use in commerce. The petitioner has no further role in the proceeding.		Commenced by the filing of a petition with the TTAB.	
Response/ Defenses	Registrant must provide documentary and testimonial evidence of use. For registrations issued under Sec. 44(e) or 66(a), Registrant may offer evidence showing that any nonuse is due to special circumstances that excuse such non-use	Registrant can provide documentary and testimonial evidence of use. Excusable non-use will not be considered for any goods/services registered under Section 1 of the Act.	Registrant can provide evidence of use pursuant to TTAB rules . For registrations issued under Sec. 44(e) or 66(a), registrant may offer evidence showing that any nonuse is due to special circumstances that excuse such non-use. TMA Sec. 225(b) (p. 151)	Registrant can provide evidence of use pursuant to TTAB rules . For registrations based on 1(a): Even if there has been a three-year period of non-use, registrant can seek to show that it did not have an intention not to resume use. For registration based on 44(e) or 66(a): Even if there has been a three-year period of non-use, registrant can seek to show that it did not have an intention not to commence (or resume) use.
Estoppel	Yes, as to another expungement proceeding for the particular goods and services found to be in use in commerce in an earlier expungement proceeding. Sec. 2.92(d)(1) .	Yes, as to another reexamination proceeding for the particular goods and/or services found to have been used in commerce in a prior reexamination proceeding. Sec. 2.92(d)(2) .	Not specifically addressed in the rule itself. The comments to the rule say “termination of an expungement or reexamination proceeding in favor of the registrant does not bar future nonuse cancellation actions with respect to the registration.”	No.
Official Fees	\$400/class		\$600/class with possible refund of \$200 if default judgment issues because there is no appearance by the registrant and no filings other than a petition to cancel that solely alleges abandonment or nonuse 37 C.F.R § 2.114(a)(2)	
Petitioner Costs	Conducting a reasonable investigation and preparing/filing the petition with itemized index.		Beyond filing the petition, unknown at this time, but presumably could involve briefing the sufficiency of the registrant’s evidence of use or excusable non-use.	Possibly become embroiled in a fully-litigated trial on the merits, including whether the registrant’s intent is sufficient to avoid a finding of abandonment, and possibly face a counter-claim for cancellation of its own trademark registration.

Resources:

Trademark Modernization Act: <https://www.congress.gov/116/cprt/HPRT42770/CPRT-116HPRT42770.pdf#page=2606>

Federal Register Notice implementing TMA: <https://www.federalregister.gov/documents/2021/11/17/2021-24926/changes-to-implement-provisions-of-the-trademark-modernization-act-of-2020#p-45>

USPTO Examination Guide 1-21

Expungement and Reexamination Proceedings Under the Trademark Modernization Act of 2020: <https://www.uspto.gov/sites/default/files/documents/TM-ExamGuide-1-21.pdf>